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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/642,892 | 08/18/2003 | Raymond V. Calvesio | RA-5621 | 3356 |

27516 7590 11/15/2004
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EXAMINER

WEBB, JAMISUE A

| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,892

Applicant(s)

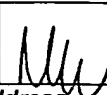
CALVESIO ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

- A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 8/29/02. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claim Objections

2. Claims 1, 5 and 10 are objected to because of the following informalities: They include periods after the numerating of steps. A period signifies the end of a sentence and therefore the end of the claim. The applicant has already provided parenthesis around the letters a and b, the examiner suggest deleting the periods from the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3-15, 17-30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 3 recites the limitation "the obtaining step" and "the comparing step". There is insufficient antecedent basis for this limitation in the claim.

6. Claim 5 recites the limitation "the day of travel" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

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7. Claim 10 recites the limitation "the record" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 10 recites the limitation "the collected identification indicia" in line 4. There is insufficient antecedent basis for this limitation in the claim. The examiner suggest using the word "unique" in the phrase, due to the fact that the applicant claimed it as unique previously.

9. Claim 11 recites the limitation "the retrieving step". There is insufficient antecedent basis for this limitation in the claim.

10. Claim 17 recites the limitation "the country of destination" in line 2. There is insufficient antecedent basis for this limitation in the claim.

11. With respect to Claim 19: the phrase "after the international border crossing has been completed, utilizing an automated clearance process to allow the traveler to enter a country" is indefinite. If the international border crossing has been already completed then the traveler has already entered the country, therefore it is unclear to the examiner how and why the automated clearance process is done to "allow" a traveler to enter the country when the traveler is already in the country.

12. Claim 20 recites the limitation "the automated checks" in line 4. There is insufficient antecedent basis for this limitation in the claim. Previously the claims stated "one or more automated checks", therefore allowing the phrase to be singular. Claim 20 recites the limitation in plural form "the automated checks", therefore it is unclear if previously there is only one check, what this phrase is referring to.

13. Claim 22 recites the limitation "the storing step" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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14. Claim 23 recites the limitation "the data processing" in line 5. There is insufficient antecedent basis for this limitation in the claim. Is this the data processing system?

Claim Rejections - 35 USC § 101

Claims 1, 2, and 5-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis for this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

In the present case, claims 1, 2 and 5-12 only recite an abstract idea. The recited steps of merely utilizing an automated check-in process, does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pen and paper. The word automated is only a nominal recitation of the term and the claims do not recite any structure in the claims that lends weight to how the check-in process is automatic. Automated merely means that it is done without further instruction, it does not

require the use of a computer. These steps only constitute an idea of how to utilize an automated check-in process for travelers crossing an international border.

Additionally, for a claimed invention to be statutory, the claimed must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a method for allowing travelers to cross international borders using a check-in process (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1, 2, and 5-22 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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17. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes et al.

(US-2002/0198731) in view of Sehr (6,085,976).

18. With respect to Claims 1, 23 and 31: Barnes discloses the use of a method of processing international travelers (see abstract) comprising the steps of: enrolling a traveler in a travel system (page 1, paragraph 0006) and at the time of travel the passenger checking in and completes activities to enable international border crossing (See Figure 2). The examiner considers purchasing the ticket to be enrolling prior to the time of travel, due to the fact that a ticket must first be purchased before traveling.

19. Barnes however, fails to disclose an automated check-in process. Sehr discloses a smart card for traveling, with a travel system that provides an automated check in procedure, where the passengers enrolls prior to check in and the card carries information pertaining to international travel (Column 11, lines 31-59, and Column 23, lines 21-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the check in process of Barnes, to make it automatic, as disclosed by Sehr, in order to reduce administrative costs, improve productivity, better quality of service and to produce higher revenues. (See Sehr, Column 2)

20. With respect to Claim 2: See Barnes Figure 3 with corresponding detailed description.

21. With respect to Claims 3 and 27: See Barnes Figure 4 with corresponding detailed description.

22. With respect to Claims 4, 5, 9 and 28: See Barnes Abstract, and Page 2 Paragraph 0020.

23. With respect to Claims 6, 7 and 26: See Barnes, Page 3, Paragraph 0027.

24. With respect to Claim 8: See Barnes, Page 2, paragraph 0021.

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25. With respect to Claims 10 and 11: See Barnes, Figures 2-4.
26. With respect to Claim 12: See Sehr, Column 8, lines 3-58.
27. With respect to Claim 13: Barnes discloses the traveler filling out electronic travel forms (See reference numeral 260, and page 4, paragraph 0037 and 0039). The examiner considers this to be a form of a questionnaire. Barnes also discloses the use of a security interview that is conducted (See Page 2, paragraph 0021), which the examiner considers to be a form of a questionnaire also.
28. With respect to Claim 14: See Barnes, Page 4, Paragraph 0038 and 0039.
29. With respect to Claim 15: See Barnes, Page 4, Paragraph 0032.
30. With respect to Claims 16 and 25: See Sehr, Column 7, lines 25-64. Sehr discloses a travel center to be a self-service machine in such places as airports, railroad stations and travel agencies. The examiner considers this to be a form of a kiosk.
31. With respect to Claims 17 and 30: Barnes, discloses automated checks being done (Page 4, paragraph 0038), which the examiner considers fully capable of being done for the purpose determining any risk of threats.
32. With respect to Claims 18-20, 24, 29 and 32: See Barnes, Page 4, paragraphs 0037-0039.
33. With respect to Claim 21: See Sehr, column 4, lines 44-53.
34. With respect to Claim 22: See Sehr, abstract and column 4, lines 26-42.

Conclusion

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Udelhoven et al. (US 2002/0077871) discloses the use of a traveler service center,

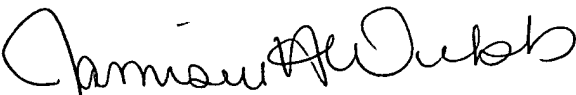
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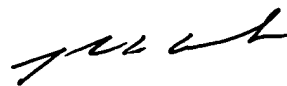
Dutta et al. (US 2002/0169692) discloses the use of a method and system for facilitating international travel, Walker et al. (6,332,129) discloses the use of a questionnaire used in a commerce system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamisue Webb


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